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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re John M. Beaman

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Serial No. 76/113,622
Serial No. 76/113,623
Serial No. 76/113,624

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Edwin D. Schindler of the Michael I. Kroll Law Office for John M. Beaman.

John E. Michos, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Seeherman, Chapman and Bottorff, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

The three applications involved herein were filed on August 21, 2000 by John M. Beaman (a United States citizen) to register on the Principal Register the marks PAC (application Serial No. 76/113,622), PAK (application Serial No. 76/113,623) and PACK (application Serial No. 76/113,624), all for “prepackaged medication” in

International Class 5. Applicant asserts a bona fide intention to use the mark in commerce in each application.

The Examining Attorney has refused registration in each application under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark (PAC or PAK or PACK), when used on applicant's goods, is merely descriptive thereof.

There is a second basis for refusal in each of the three applications. Specifically, registration has been refused based on applicant's failure to comply with a requirement for a more definite identification of goods.

When the requirement for a more definite identification of goods and the refusal to register were made final, applicant appealed in each application. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

In view of the common questions of law and fact which are involved in these three applications, and in the interests of judicial economy, we have consolidated the applications for purposes of final decision. Thus, we have issued this single opinion.

Turning first to the question of the identification of goods, the Examining Attorney did not accept the original identification of goods "prepackaged medication," and

suggested applicant adopt the following identification, if accurate: "prepackaged medication for use in the treatment of [indicate condition/illness the goods are used to treat, e.g., hypertension]."

Applicant contends that "prepackaged medication" is not in and of itself an indefinite phrase; that because the Examining Attorney found no prior registration or pending application which might conflict with applicant's marks the suggested limitation is unnecessary and unduly restrictive; and that because each application is based on a bona fide intention to use the mark and the scope of the goods is still unclear, if applicant is required to enter the limitation it would undermine the "intent-to-use" provision of the Trademark Act.

The Examining Attorney explained that the specific information about the condition or illness medications are used to treat is required for all pharmaceuticals, medications and therapeutic agents; that the particular use and nature of the medications is crucial in determining whether a likelihood of confusion exists, particularly with regard to how the goods will be used, for what purpose, and the channels of trade in which they will travel; that "medications" must therefore be identified with specificity in order to avoid the issuance of unnecessary refusals

under Section 2(d) of the Trademark Act; and that the more specific identification required by the Examining Attorney follows United States Patent and Trademark Office (USPTO or Office) policy as reflected in the "Acceptable Identification of Goods and Services Manual" (available at the uspto.gov website).[1]

Section 1(b)(2) of the Trademark Act, 15 U.S.C. §1051(b)(2), requires that the written application specify the goods or services on or in connection with which applicant intends to use the mark. Trademark Rule 2.32(a)(6) requires, in relevant part, that a trademark application must set forth "the particular goods or services" with which the mark is or will be used. See also, Trademark Rule 2.33(b)(2). Further, the TMEP §1402.01 (Third Edition 2002) states that the identification of goods or services must be specific and definite. See analogously, TMEP §1402.03(d) (Third Edition 2002) (regarding specificity required with regard to "computer programs").

It is within the discretion of the USPTO to require that the goods or services be specified with particularity.

[1] The Examining Attorney's request that the Board take judicial notice of this "ID Manual" is granted, but said request is actually unnecessary as the Board is free to consider (if not obligated to review and consider) such formalized official statements and codifications of Office policy.

See In re Societe Generale des Eaux Minerales de Vittel S.A., 1 USPQ2d 1296, 1298 (TTAB 1986), rev'd on other grounds, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1998).

As stated in TMEP §1402.01 (Third Edition 2002): "To 'specify' means to name in an explicit manner. ... The identification of goods or services must be specific, definite, clear, accurate and concise. ..." The above-mentioned USPTO "ID Manual" includes examples of acceptable identifications of goods such as "pharmaceutical preparations, namely,...," "pharmaceutical preparations for the treatment of ...," "allergy medications," "pain relief medications," and "burn relief medications."

The Office requirement for a specific identification of goods (or services) is not curtailed or minimized because a party files an intent-to-use application. In fact, in light of intent-to-use based applications, there is a particular need for all entities to be aware of the precise goods and/or services covered by the marks applied for by applicants. Likewise, the fact that the scope of applicant's involved medications is not yet known, does not obviate the Office's requirement for a specific identification in all such applications.[2] Particularly with

[2] In the first Office action, the Examining Attorney requested (in each case) informational materials such as promotional and

regard to applications for goods such as "pharmaceuticals" and "medications" it is clear that the specific use of the medication is required so that the applicant is not accorded greater rights than those to which he is entitled. The use of a mark for a particular medication is not necessarily likely to cause confusion with the use of a similar mark for other medications. However, if applicant were to obtain a registration for medications without any limitation as to their nature, such a registration could prevent the registration of a third-party's mark even though the respective medications were substantially different.

Thus, the problem with applicant's identification of goods is that it does not identify applicant's "prepackaged medications" with any specificity (i.e., "prepackaged medications, for the treatment of ...). While it is true that the word "medications" is not unclear in the sense of its commonly understood English meaning, it is however also true that the term is unclear and imprecise in the context of the identification of goods in a trademark application.

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advertising materials. Applicant responded (in each case) that his attorney would determine if such materials existed and if so, they would be filed "in the near future." No such materials were ever submitted in any of these three applications. However, because the Examining Attorney never repeated this requirement, it is not an issue in these appeals.

See In re Societe Generale des Eaux Minerales de Vittel S.A., supra.

The Examining Attorney's requirement for a more definite identification of goods is proper.

Turning to the issue of mere descriptiveness, it is the Examining Attorney's position that the terms PAC, PAK and PACK each connote a significant characteristic or feature of the goods, namely, that the medication is sold in a pack in prepackaged form; and that it is immediately clear to consumers that "applicant has arranged his individual component medications into a prepackaged unit which is sold in a pack" (brief, p. 8). With regard to the terms PAC and PAK, the Examining Attorney specifically contends that these are simply misspellings or novel spellings of the descriptive word PACK; and that these misspellings or novel spellings do not alter how purchasers would perceive the terms in relation to the identified goods.

In support of the descriptiveness refusals, the Examining Attorney has made of record (in each case) the following dictionary definitions of "pack":

> (1) noun ... 3. a small package containing a standard number of identical or similar items: a pack of matches, The American Heritage

> Dictionary (Fourth Edition 2000); and
>
> (2) noun 1. ... c.(1) a number of individual components packaged as a unit <a pack of cigarettes>. (2) container, Merriam Webster's Collegiate Dictionary (Online 2001).

In addition, the Board takes judicial notice of the following dictionary definitions from The Random House Dictionary Unabridged (Second Edition 1987):

> (1) pac: n. pack;
>
> (2) pak: n. pack; package; and
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> (3) pack: n. ... 2. a definite quantity or standard measure of something wrapped up or otherwise assembled for merchandising ... .

The Examining Attorney also submitted photocopies of excerpted stories retrieved from the Nexis database to show that consumers understand the term "pack" (and the equivalents "pac" and "pak") to refer to a type of medication packaging or container. Examples of these materials are reproduced below:

> Headline: The Need To Know Drives Pharma Labeling Market
> Package inserts/outserts have become a legal requirement with the move toward dispensing patient packs of medication. "Paper, Film & Foil Converter," January 2001;

> Headline: Errors Put on Trial; Meeting's Focus Is Patient Safety, Medical Mistakes
> ... Drugs come in different strengths even though studies show prepackaged blister-pack medications reduce errors.
> ... "The Richmond Times Dispatch," April 21, 2001;
>
> Headline: Prescribing Update; New Prescription Drugs
> ... Monistat 3 Combination Pack (Medication)..., "Patient Care," May 15, 2001; and
>
> Headline: District Municipal Corporations Asked to Generate Maximum Revenue
> ... It was decided that henceforth all medicines will be purchased directly from the companies concerned. The packs of medicines will carry the name of KMC. "Business Recorder, July 11, 2001.

Applicant urges reversal arguing that the marks (PAC, PAK and PACK) are suggestive or even arbitrary "inasmuch as an extremely wide-range of goods throughout the economy are 'prepackaged' and upon hearing or seeing the mark [PAC or PAK or PACK], one would not otherwise be aware as to what was 'packaged,' let alone what was packaged was medication" (brief, p. 6 -- emphasis in original); that consumers would have to engage in a multi-step reasoning process, and they would have to devote a reasonable measure of thought, conjecture and speculation in order to be able to guess what goods are offered under these trademarks; that the

Examining Attorney found no conflicting pending or registered marks, thus supporting an inference that competitors do not use and do not need to use these marks in order to market their goods; and that any doubt is to be resolved in applicant's favor. Further, applicant argues that neither PAC nor PAK is a word in the English language; and that PAC is often an abbreviation for "political action committees."

The test for determining whether a mark is merely descriptive is whether the term or phrase immediately conveys information concerning a significant quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used or is intended to be used. See In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978); In re Eden Foods Inc. 24 USPQ2d 1757 (TTAB 1992); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). A mark does not have to describe every quality, characteristic, function, ingredient, attribute or feature of the goods or services in order to be found merely descriptive; it is sufficient for the purpose if the mark describes a single significant quality, feature, function, etc. thereof.

Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or

on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the term or phrase is being used or is intended to be used on or in connection with those goods or services, and the impact that it is likely to make on the average purchaser of such goods or services. See In re Consolidated Cigar Co., 35 USPQ2d 1290 (TTAB 1995); and In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985). Rather, the question is whether someone who knows what the goods or services are will understand the term or phrase to convey information about them. See In re Home Builders Association of Greenville, 18 USPQ2d 1313 (TTAB 1990).

We agree with the Examining Attorney that the asserted marks, PAC, PAK and PACK, each immediately describes a significant characteristic or feature of the goods on which applicant intends to use his marks. Each term immediately informs consumers that applicant's goods, "prepackaged medication," are sold with the component medications already arranged into a prepackaged unit which is sold as a pack.

The dictionary listings for the words establish their meanings in the English language. Not only are the terms "pac" and "pak" the phonetic equivalent of the word "pack, but both "pac" and "pak" appear in the dictionary, and both are defined as "pack." Consumers would understand these two terms to be the equivalent of "pack" and its normally understood meaning relating to a container or a package which contains a number of similar units assembled into one package. See In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ 505, footnote 9 (CCPA 1980); In re State Chemical Manufacturing Co., 225 USPQ 687 (TTAB 1985); and In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982).

Moreover, the Nexis evidence show that there is a particular recognized meaning for "pack" (or "pac" or "pak") with relation to medications. Thus, the record establishes that consumers will view the terms "pac," "pak" and "pack" as descriptive of prepackaged medication. The fact that many types of goods are prepackaged does not negate the descriptive meaning of the terms in relation to medication.

Purchasers and prospective purchasers of applicant's prepackaged medication, upon consideration of the terms

"pac," "pak," or "pack" used in connection therewith, will immediately know a significant feature of his product, i.e., that it is medication sold prepackaged in units. Such purchasers or prospective purchasers will not need to engage in even the slightest degree of cogitation or reasoning to understand the significance of these terms when used in conjunction with the product. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Omaha National Corporation, supra; In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996); and In re Time Solutions, Inc., 33 USPQ2d 1156 (TTAB 1994).

Inasmuch as the record establishes that each of these terms, PAC, PAK and PACK, unquestionably projects a merely descriptive connotation with regard to prepackaged medication, we believe that competitors have a competitive need to use these terms. See In re Tekdyne Inc., 33 USPQ2d 1949, 1953 (TTAB 1994); and 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:18 (4th ed. 2001).

Decision: The requirement for a more definite identification of goods, and the refusal to register under Section 2(e)(1) are affirmed in each application.